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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,647	06/07/2000	Joe McCollum	C1151-7000	8728
37462	7590	11/13/2009		
LANDO & ANASTASI, LLP ONE MAIN STREET, SUITE 1100 CAMBRIDGE, MA 02142				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
NOTIFICATION DATE		DELIVERY MODE		
11/13/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ll-a.com
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Office Action Summary

Application No.

09/589,647

Applicant(s)

MCCOLLUM ET AL.

Examiner

Natalie A. Pass

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 23 July 2009. Claims 1-2, 16 have been amended. Claims 1-26 remain pending.

Claim Rejections - 35 USC § 101

2. The rejection of claims 1, 3-9, 16-22, 25-26 under 35 U.S.C. §101 is hereby withdrawn due to the amendment filed 23 July 2009.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Newly amended claims 1, 2, 16 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “containing shipping and handling instructions,” as disclosed in claim 1, lines 7-8, claim 2 at line 8, claim 16, at lines 7-8; and

- “absent intervention of an approvals agent,” as disclosed in claims 1, 2, and 16 at line 11, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 7 June 2000. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) Claims 3-15, 17-26 incorporate the features of independent claims 1, 2, 16, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 7 June 2000.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 10-15, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for substantially the same reasons as in the previous Office Action (paper number 20090108). Further reasons appear hereinbelow.

(A) Claim 2 continues to recite limitations in “*means plus function*” language. The scope of a “means” limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. If there is no disclosure, or if there is insufficient disclosure, of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph. See MPEP § 2181 through § 2186. Moreover, as held in recent court cases, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6, and simply reciting “software” without providing some detail about the means to accomplish the function is not enough. See *Aristocrat Techs. Austl. Pty v. Int’l Game Tech.*, ___ F.3d ___, 2008 U.S. App. LEXIS 6472, at *10 [86 USPQ2d 1235] (Fed. Cir. Mar. 28, 2008).

(B) Claims 10-15, 23-24 incorporate the features of independent claim 2, through dependency, and are also rejected.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the 23 July 2009 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 3-5 above in the next communication sent in response to the present Office Action.

9. Claims 1-6, 8-12, 14-18, 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton, United States Patent Number 7, 028, 049 for substantially the same reasons as in the previous Office Action (paper number 20090108), and further in view of Rock et al., United States Patent Number 6, 032, 120. Further reasons appear hereinbelow.

(A) Claim 1 has been amended to recite:

- "and containing shipping and handling instructions," in lines 7-8;
- "absent intervention of an approvals agent," in line 11; and
- "approving, by the processing center, the cover letter and the patient authorization letter," in lines 16-17.

As per amended claim 1, Shelton teaches a method of obtaining a patient record as analyzed and discussed in the previous Office Action (paper number 20090108), comprising:

providing to the requestor a single cover letter having “a tracking number” (reads on “human readable information”) identifying the order requested from the online location (Shelton; column 10, lines 28-40, column 10, line 33 to column 11, line 3, column 12, lines 50-55, column 13, lines 10-26) and containing shipping and handling instructions (Shelton; column 10, lines 33-65); Examiner interprets Shelton’s teachings of “... [...] ... an order form ... [...] ... to retrieve and deliver the information ... [...] ... media on which the document can be delivered ... [...] ... to be forwarded to the requesting party ... [...] ... authorized mode of transfer, and the like” to teach a form of “shipping and handling instructions;”

sending, by the requestor, absent intervention of an approvals agent, to a “secure Request Cache ... [...] ... linked to [a] server ... [...] ... ” (reads on “a processing center”) (Shelton; column 8, lines 1-4, column 10, line 53 to column 11, line 9, column 12, lines 60-67), after providing to the requestor the “order form” [reads on “cover letter”] and after providing to the requestor the patient authorization letter, the cover letter along with the patient authorization letter to a “secure Request Cache ... [...] ... linked to [a] server ... [...] ... ” (reads on “a processing center”) (Shelton; column 12, lines 60-67), for completing the order (Shelton; column 10, lines 33-39, column 11, lines 4-30, 49-52, column 12, lines 4-9); and

in response to the requestor sending the cover letter and the patent authorization letter, “[w]hen Approvals Agent 16 receives all of the required authorizations for release of the records request” (reads on “after receiving from the requestor the cover letter and the patient

authorization letter;”) approving, by the software “Approvals Agent” (reads on “processing center”), the cover letter and the patient authorization letter (Shelton; column 12, lines 4-20), requesting, by the “Approvals Agent” (reads on “processing center”) to a “data administrator” (reads on “shipping location”) to “retrieve and transmit” (reads on “ship”) the patient record concerning the identified patient to “the requesting physician” (reads on “a destination location”) (Shelton; column 12, lines 4-9); Examiner interprets Shelton’s teachings of “[w]hen Approvals Agent 16 receives all of the required authorizations for release of the records request, it will automatically generate ... [...] ... transmit the documents to the requesting physician... [...] ... the requested mode of transmittal ... [...] ... mail, fax, overnight delivery or network transmission ... [...] ...” (Shelton; column 12, lines 4-13) to teach a form of approving by the processing center the cover letter and the patient authorization letter.

Although Shelton teaches providing to the requestor a single cover letter having “a tracking number” (Shelton; column 12, lines 50-55), Shelton fails to explicitly disclose a machine readable identifier identifying the order requested from the online location.

However, the above features are well known in the art, as evidenced by Rock.

In particular, Rock teaches a method disclosing
a machine readable identifier identifying the order requested from the online location
(Rock; column 2, lines 8-11, column 4, lines 15-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Shelton to include these limitations, as taught by Rock, with

the motivations of making the process of accessing medical information more efficient and of eliminating typographical errors (Rock; column 2, lines 8-11, column 4, lines 15-28).

As per the remainder of the amendments to claim 1, these appear to have been made merely to correct minor typographical or grammatical errors, or to overcome rejections under 35 U.S.C. §101. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090108, section 8, pages 6-8), and incorporated herein.

(B) Claims 3-6, 8-9, 15, 21-22 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20090108, section 8, pages 8-10), and incorporated herein.

(C) Amended claim 2 differs from amended method claim 1, in that it is a system rather than a method for obtaining a patient record containing information concerning an identified patient using an online location.

System claims 2, 10, 11, 12, 14, 23-24 repeat the subject matter of claims 1, 4, 3, 5, 8, 21-22, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claims 1, 4, 3, 5, 8, 21-22 have been shown to be fully disclosed by the combined teachings of Shelton and Rock in the above rejection of claims 1, 4, 3, 5, 8, 21-22 it is

readily apparent that the system disclosed by Shelton and Rock includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 4, 3, 5, 8, 21-22 and incorporated herein.

(D) Amended claim 16 differs from claim 1 in that it is a method of ordering, by a requestor, a patient record containing information concerning an identified patient using an online location on a computer server rather than a method of obtaining a patient record containing information concerning an identified patient using an online location on a computer server.

Claims 16-18, 20, 25-26 repeat the features of claims 1, 4, 5, and 8, 21-22, respectively, and are therefore rejected for the same reasons given above in the rejections of claims 1, 4, 5, and 8, 21-22, and incorporated herein.

10. Claims 7, 13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton, United States Patent 7, 028, 049, and Rock et al., United States Patent Number 6, 032, 120, as applied to claims 1, 2, and 16 above, and further in view of Hacker, United States Patent 6, 988, 075, for substantially the same reasons as in the previous Office Action (paper number 20090108). Further reasons appear hereinbelow.

(A) Claims 7, 13, 19 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20090108, section 18, pages 10-12), and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 23 July 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 23 July 2009.

(A) With regard to Applicant's arguments on pages 8-10 of the response filed 23 July 2009 regarding "means plus function" language recited in claims 2, 10-15, 23-24, Examiner thanks Applicant for the clarification for this language as presented on pages 8-10, however Examiner submits that, as presented in the previous Office Action (paper number 20090108), the scope of a "means" limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. See MPEP § 2181 through § 2186. If there is no disclosure of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

Moreover, as discussed in the previous Office action (paper number 20090108), recent court cases have held that simply reciting "software" without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, ___ F.3d ___, 2008 U.S. App. LEXIS 6472, at *10 [86 USPQ2d 1235] (Fed. Cir. Mar. 28, 2008) ("For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure

designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6") (emphasis added). As submitted in the previous Office Action, the Court in *Aristocrat* did not require a listing of source code or a highly detailed description of the algorithm to be used to achieve the claimed functions in order to satisfy 35 U.S.C. §112 paragraph 6. It did require, however, the disclosure of at least the algorithm that transformed the general purpose microprocessor to a "special purpose computer programmed to perform the disclosed algorithm." *WMS Gaming*, 184 F.3d at 1349. Thus, as stated in the previous Office Action (paper number 20090108), the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm or description of structure corresponding to the claimed function to provide the necessary structure under 35 U.S.C. §112 paragraph 6.

Accordingly, Applicant's discussion in the response filed 23 July 2009 with regard to recited "*means plus function*" language fails to overcome the disclosed structure requirements needed to satisfy 112, second paragraph requirements, as described in detail in the previous Office Action (paper number 20090108).

(B) Applicant's arguments at pages 10-14 of the 23 July 2009 response regarding the newly added limitations of a "machine readable identifier" have been fully considered but they are moot in view of the new ground(s) of rejection.

As per Applicant's arguments that the remaining limitations claimed in Applicant's invention are not taught or suggested by the applied references, Examiner respectfully disagrees.

Examiner submits that all of the limitations which Applicant disputes are missing in the applied references, including the features newly added in the 23 July 2009 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Shelton, Rock, and Hacker, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC §102 and §103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20090108), and incorporated herein.

As per Applicant's arguments that the data administrator, a person, provides the only path to completion of the order in the Shelton reference, Examiner respectfully disagrees, and submits that Shelton has various embodiments, some of which utilize "agent software." Examiner respectfully submits that Shelton's "Approvals Agent" consists of "a workflow agent ... [...] ... to seek the relevant approvals ... [...] ... can automatically generate a fax request, ... [...] ... or machine-generated conventional letter" (emphasis added) (Shelton; column 10, lines 53-61) and "[t]hus, when a request for release is received, the relevant attributes ... [...] ... automatically obtain customized information tailored to each individual data item" (emphasis added) (Shelton; column 10, line 66 to column 11, line 9) and "an automatic pre-authorization ... [...] ... release of ... [...] ... medical data to such doctor ... [...] ..." (Shelton; column 11, lines 4-9); Examiner interprets these teachings to be a form of "sending, by the requestor, absent intervention of an [human] approvals agent," as recited in newly amended claims 1, 2, and 16.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. **Any response to this final action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on 9-6:30 Monday - Thursday and alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
November 9, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686